

REMARKS

In the Office Action mailed 5/25/2006, 1-13 were rejected as being obvious over the prior art under 35 U.S.C. §103. Claim 14 was indicated as being allowable if rewritten in independent form including all of the limitations of the base claim (claim 1).

In response, Applicant has herein amended claim 1 to more clearly distinguish the claimed invention from the cited prior art, despite Applicant's belief that such amendment was necessary, but to expedite reissue of the instant patent. Applicant now respectfully asserts that the claims are in condition for allowance and reissue.

To repeat its previous assertion, Applicant simply amends Claim 1 in view of the Examiner's suggestion, and to make the specific aspects of the claimed limitations clearer to the Examiner. Applicant clarifies this point in order to avoid file wrapper estoppel, which would be inappropriate in this matter.

For the reasons set forth below, reconsideration of the rejections is requested and allowance of the present application is submitted to be in order.

Patentability of Claim 1 (as amended) and claims dependent thereon

The Examiner has cited the combination of *Brooks et al.*, and *Mayr*, U.S. Patent Nos 5,513,865 and 5,249,819, respectively, in rejecting Applicant's independent claim 1. It is respectfully noted that *Mayr* was cited by this Examiner in unsuccessfully preventing the patenting of the parent application to this reissue application.

Applicant respectfully requests that the Examiner review his and the undersigned statements regarding the extrusion limitation, its significance related to claim 1, its lack of

disclosure in any of the cited art, as well as the manufacturing realities related to the production cost of extruded units.

First, claim 1 does claim does recite: “an elongated *extruded* aluminum metal board;” products that are extruded are unique (as compared to cast or machined products) – this is not a “product by process” limitation – the recited **closed cavity** structures cannot be made by casting (at least not without having a structural core in the closed cavities), and would simply be unworkable if machined because the joints could simply not be reached for fabrication. As such, **extruded**, in this case, truly relates to the final product itself – it is not product by process because the product can only be made by the extrusion process (i.e. the structure would be different than claimed if not extruded).

Second, extrusion is not a cost-saving approach to aluminum products; the Examiner has not provided any substantiation for his conclusion in this regard, but in the real world, machining or casting is almost always less expensive. Applicant’s choice to use extrusion to devise its claimed board was a *structural* decision, and not a cost-saving measure. If the Examiner would kindly provide support for his conclusion to the contrary, perhaps Applicant could address the evidence specifically. In fact, the *Mayr* structure, which Examiner relies upon in rejecting Applicant’s claims, discloses the need to glue the “upper shell part 25” to the “lower shell part 27.” Clearly, this is not unitary, and does require additional processing in order to assemble/complete fabrication.

Finally, since the significance of the extrusion and unitary limitations relates to the qualities of the finished product, and not to the cost of manufacturing, there must be more evidence of a suggestion to combine or modify the prior art in order to arrive at Applicant’s

claimed invention. The structure must be suggested, and not the manufacturing process. Since the structure is not suggested, the claim is not obvious over the prior art.

As for the specific disclosures of Mayr, the following limitations of Claim 1 (at least) are not disclosed or suggested by Mayr:

1. extruded, unitary [Mayr is not a unitary extruded structure]
2. one of said closed cavity forming members located along a central longitudinal axis of said board
3. one of said closed cavity forming members adjacent to said left edge
4. and one of said closed cavity forming members adjacent to said right edge [Mayr does not disclose a central cavity, [plus] another cavity at the right edge, [plus] another cavity at the right edge – in fact, the Mayr cavities do not reach the edges, but rather define alternate embodiments of the “central hollow core 3”]

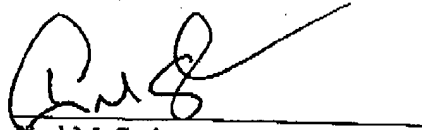
Mayr, therefore, does not disclose or hint at each and every element of Applicant's claim 1. If the Examiner does consider Mayr's structure to be only an obvious step away from Applicant's claimed structure, then why Brooks is relied upon for the proposition that aluminum skateboards are well-known. Even assuming that to be true, this does not mean the Applicant's claimed structure, including the aluminum construction, is obvious (i.e. even if the material is obvious, that does not make the structure obvious).

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue. If any impediment to the allowance of the claims remains after consideration of this request for reconsideration, and such impediment could be alleviated during a telephone interview, the Examiner is invited to telephone the undersigned so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

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